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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,653	05/19/2005	Zoltan Laszlo Benko	61,904A	1637
25212 7590 01/10/2008 DOW AGROSCIENCES LLC 9330 ZIONSVILLE RD INDIANAPOLIS, IN 46268			EXAMINER COPPINS, JANET L	
			ART UNIT 1626	PAPER NUMBER
			MAIL DATE 01/10/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/535,653	Applicant(s) BENKO ET AL.	
	Examiner Janet L. Coppins	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 3-6 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 is/are allowed.
- 6) ☒ Claim(s) 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Claims 1-6 are pending in the instant application.

#### *Priority*

1. The instant application is a 371 of International Application No. PCT/US2003/041067, filed December 19, 2003.

#### *Lack of Unity*

2. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention (which will be rejoined with the pending compound claims) to which the claims must be restricted:

Group I, claims 1 and 2, drawn to compounds of the formula of claim 1 and their compositions, not required for Groups II-III, classified in various subclasses of classes 546, 548, 549 or 564. A further election of a single disclosed compound is required if this group is elected.

Group II, claims 3-6, drawn to methods of using compounds of claim 1, not required for Groups I and II, classified in various subclasses of class 514. A further election of a single disclosed compound is required if this group is elected.

3. Applicant is also required to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. Upon thorough consideration of the claims, the examiner has determined that a lack of unity of invention exists, as defined in Rule 13.

PCT Rule 13.1 states that the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

PCT Rule 13.2 states that unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

Annex B, **Part 1(a)**, indicates that the application should relate to only one invention, or if there is more than one invention, inclusion is permitted if they are so linked to form a single general inventive concept.

Annex B, **Part 1(b)**, indicates that "special technical features" means those technical features that as a whole define a contribution over the prior art.

Annex B, **Part 1(c)**, further defines independent and dependent claims. Unity of invention only is concerned in relation to independent claims. Dependent claims are defined as a claim that contains all the features of another claim and is in the same category as the other claim. The category of a claim refers to the classification of claims according to subject matter,

e.g. product, process, use, apparatus, means, etc.

Annex B, **Part 1(e)**, indicates the permissible combinations of different categories of claims. **Part 1(e(i))** states that inclusion of an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product is permissible.

Annex B, **Part 1(f)** indicates the "Markush practice" of alternatives in a single claim. **Part 1(f(i))** indicates the technical interrelationship and the same or corresponding special technical feature is considered to be met when: (A) all alternatives have a common property or activity, and (B) a common structure is present or all alternatives belong to a recognized class of chemical compounds. Further defining (B) in Annex B, **Part 1(f)(i-iii)**, the common structure must; a) occupy a large portion of their structure, or b) the common structure constitutes a structurally distinctive portion, or c) where the structures are equivalent and therefore a recognized class of chemical compounds, each member could be substituted for one another with the same intended result. That is, with a common or equivalent structure, there is an expectation from knowledge in the art that all members will behave in the same way. Thus, the technical relationship and the corresponding special technical feature result from a common (or equivalent) structure that is responsible for the common activity (or property). **Part 1(f(iv))** indicates that when all alternatives of a Markush grouping can be differently classified, it shall not, taken alone, be considered justification for finding a lack of unity. **Part 1(f(v))** indicates that when dealing with alternatives, it can be shown that at least one Markush alternative is not novel over the prior art, the question of unity of invention shall be reconsidered, but does not imply that an objection shall be raised.

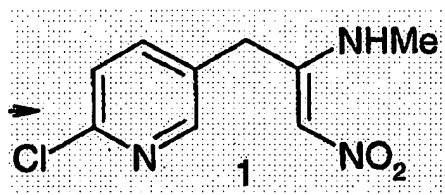
5. The claims herein lack unity of invention under PCT Rule 13.1 and 13.2, since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed contain an (carbocyclic or heterocyclic ring)-alkenylamine backbone in common, which does not define a contribution over the prior art (**variables excluded**). Attached to the instant office action is a copy of a reference that provides that the technical feature, which can be taken as a whole amongst all the alternatives, as depicted above, is not a 'special technical feature' as defined in PCT Rule 13.2, by failing to define a contribution over the prior art, as it was known in the art prior to the filing of the instant application. Please refer to the CAPLUS listing, Accession Number 2004:892690, abstract of Sadikov, K. et al.

Further, under "Combinations of Different Categories of Claims {Annex B, Part 1(e)(I)}, Applicants are permitted a process for examination on the merits whereas Applicants are claiming several different processes. For example, applying the compound of claim 1 topically is not the same method as administering the compound orally, since these methods involve different intracellular mechanisms and different treatment protocol. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. During a telephone conversation with Ronald S. Maciak, Reg. No. 35,262, on December 12, 2007, a provisional election was made with traverse to prosecute the invention of Group I,

drawn generically to claims 1 and 2, and the specific compound of Example 1 for examination purposes:



Compound 1, (1Z)-3-(6-chloro-3-pyridinyl)-N-methyl-1-nitro-1-propen-2-amine.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 3-6 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### *Claim Rejections - 35 USC § 112*

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claim 2 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which

it is most nearly connected, to make and/or use the invention. Applicants recite in claim 2, a composition comprising a compound of claim 1 and, "... at least one other active compound where such active compound is at least insecticidally, acaricidally or nematocidally active."

In *In re Wands*, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. § 112, first paragraph, have been described. They are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

***The nature of the invention***

In the instant case, applicants are claiming a composition comprised of a compound according to claim 1 and at least one other active compound. The nature of the invention is of a pesticidal composition further containing an insecticidally, acaricidally, or nematocidally active compound.

***The state of the prior art and the predictability or lack thereof in the art***

One skilled in the art would know that an insecticidally, acaricidally or nematocidally active compound might include such compounds as nicotine, DDT, or ivermectin. The number of possible compounds encompassed by this terminology is quite large, however, and includes thousands of "active compounds." It would be difficult to pick and choose from the many known "active compounds" as to which compound would be appropriate for controlling certain



pests, since some are applied topically as sprays or ointments, yet would be toxic if orally administered. Also, one might employ a permethrin to control acarids such as mites or ticks, but this would not be effective for controlling nematodes such as roundworms, which might require avermectin, for example.

*The amount of direction or guidance present,  
and the presence or absence of working examples*

The specification has neglected to provide any working examples of compositions that contain compounds of claim 1 plus additional active compounds. Applicants discuss suitable "active compounds" in a laundry list on pages 11-13 of the specification, but provide no further guidance. Claim 2 does not provide any indication as to the nature of the intended "active compound," (other than it being insecticidally, acaricidally or nematocidally active) therefore the quantity of experimentation would be undue to screen every possible type of active compound for the purposes of the instant invention.

*The breadth of the claims*

As stated previously, the number of compounds encompassed by this terminology is quite large and includes thousands of possible "active compounds."

*The quantity of experimentation needed*

The quantity of experimentation needed is quite high, since one would first need to determine which insect, acarid, mollusc or nematode is being controlled, and then which of the thousands of possible "active compounds" could be successfully combined with a compound of claim 1.

In order to overcome this rejection, the Examiner suggests incorporating "selected from the group consisting of" at the end of the claim and including some of the suitable active compounds or types of compounds listed on pages 11-13.

***Conclusion***

11. In conclusion, claims 1-6 are pending in the instant application, and claims 3-6 are currently withdrawn from consideration. Claim 2 is currently rejected, and claim 1 appears allowable over the prior art.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

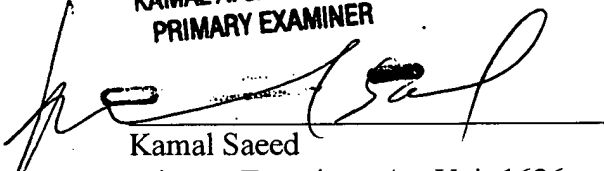
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Janet L. Coppins  
January 3, 2008

**KAMAL A. SAEED, PH.D.  
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Primary Examiner, Art Unit 1626